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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/341,287	08/19/1999	JOHN G. WOODS	LC-302/PCT/U	4956
7590 04/16/2004			EXAMINER	
Loctite Corporation Legal Department 1001 Trout Brook Crossing Rocky Hill, CT 06067			LIPMAN, BERNARD	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Serial Number: 09/341,287
Filing Date: August 19, 1999
Appellant(s): Woods et al

Vazken A. Alexanian
For Appellants

EXAMINER'S ANSWER

MAILED

APR 16 2004

GROUP 1700

This is in response to appellants' brief on appeal filed
March 22, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is
contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and
interferences which will directly affect or be directly affected
by or have a bearing on the decision in the pending appeal is
contained in the brief.

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(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendment after final rejection filed on [1] has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellants' statement of the issues in the brief is correct.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Okamoto	U.S. Patent 4,444,692
Wu	U.S. Patent 4,266,046

Yoshino, "Synthetic Studies with Carbonates. Part 6. Synthesis of 2-Hydroxyethyl Derivatives by Reactions of Ethylene Carbonate with Carboxylic Acids or Heterocycles in the Presence of Tetraethylammonium Halides or Under Autocatalytic Conditions"

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 23-28, 31 and 34-37 are rejected under 35 U.S.C. 103.

This rejection is set forth in prior Office action, the final rejection mailed February 20, 2002.

(11) Response to Argument

Appellants have argued that there is no motivation presented in the combination of references to, in fact, combine the references and reach the conclusion that the polymer of Okamoto be produced using ethylene carbonate in the presence of phase transfer catalysts instead of the ethylene oxide taught in the reference. This argument is not persuasive insofar as, more specifically, reference to Wu specifically teaches the use of ethylene carbonate for conversion of carboxylic acid entities and specifically states in column 1 that, although the prior art teaches the use of ethylene oxide for this purpose, the use of the ethylene carbonate is a distinct improvement over the use of ethylene oxide. Reference to Wu, therefore, provides direction

to one of ordinary skill in the art for the substitution of ethylene carbonate for ethylene oxide in the conversion of carboxylic acids to hydroxy functionality. The hydroxyalkylation of carboxylic acid functionality is also described in Yoshino where the benefit of using ethylene carbonate in the presence of specific phase transfer catalysts is taught and again the teaching is that this is an improvement over the use of ethylene oxide, which is stated in the first sentence of the article. Both references to Wu and Yoshino, therefore, provide motivation to one of ordinary skill in the art to substitute ethylene carbonate in the conversion of carboxyl terminated entities using phase transfer catalysts in combination with the ethylene carbonate. It would, therefore, be prima facie obvious to substitute the ethylene carbonate of the references to Wu or Yoshino for the ethylene oxide of Okamoto and the result is appellants' claimed invention. In conclusion, contrary to appellants' argument, the references themselves provide strong motivation to one of ordinary skill in the art to substitute ethylene carbonate and phase transfer catalysts in the reaction taught by Okamoto et al. using ethylene oxide. The rejection under 35 U.S.C. § 103 is, therefore, proper and should be affirmed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Lipman whose telephone number is (571) 272-1105. The examiner can normally be reached on Mondays through Fridays from 7 A.M. to 4:30 P.M.

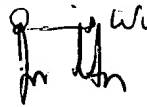
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.


Bernard Lipman
Primary Examiner
Art Unit 1713

BL:cdc
April 22, 2004

appeal conference:



Vazken A. Alexanian
Ohlandt, Greeley, Ruggiero and Perle, LLP
1 Landmark Square
10th Floor
Stamford, CT 06901-2682